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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,675	12/29/2000	James Calver	1875-04	9123

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Daniel F. Perez
Bickel & Brewer
4800 Bank One Center
1717 Main Street
Dallas, TX 75201

EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/751,675	Applicant(s) CALVER, JAMES	
	Examiner Khanh H. Le	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/29/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☒ Claim(s) 13-15, 18-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This Office Action is responsive to the original application. Claims 1-33 are pending and herein examined. Claims 1, 11, and 21 are independent.

Specification

2. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

Claims Objections

3. Claims 13-15, 18-19 should be dependent on claim 11 instead of 10. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1,4-6, 9-10, 11, 14-16,19-20, 21, 24-26, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Gershman et al., US 6401085 B1, herein Gershman.

Gershman discloses a web-based portal for customized information retrieval and display system based on customer inputted needs and preferences (see at least Figs.10A and 10B and associated text) with catalogs and customer lead generation features.

Thus, as to claims 1, 11, 21, GERSHMAN discloses

A method in a remote computer network for interactively providing user-tailored information to a user via a web-based portal wherein said remote computer network has at least one client connectable to one or more servers, said method comprising the steps of:

compiling user-provided information via an interactive template (see at least abstract, Figs.12, 13, and associated text : “personas” are interpreted as qualifying “templates” for further customization) within said web-based portal;

automatically analyzing said interactive electronic template and said user-provided information to obtain resulting user-tailored information (see at least Fig. 12 and associated text: a user “general profile” based on certain responses to the “ persona” template is considered “user-tailored information” based on which more customization is done), and

interactively rendering said user-tailored information in a web browser at a remote site within said remote computer network, in response to automatically analyzing said interactive electronic template and said user-provided information (see at least Figs. 12, 13, and associated text; col. 14 lines 5-50;col. 38-40) .

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As to claims 4, 14, 24 (dependent on claims 1, 11, and 21 respectively) GERSHMAN discloses compiling user-provided information via a pre-qualifying template within said web-based portal (see at least Figs. 12, 13 and associated text).

As to claims 5, 15, 25 (dependent on claims 1, 11, 21 respectively) developing a user profile based on said user-provided information and said user-tailored information

(see at least Fig. 12 and associated text: a user “general profile” based on certain responses to the “persona” template is considered “user-tailored information” based on which more customization is done),

transmitting said user profile to a product configurator,

automatically analyzing said user profile utilizing said product configurator to interactively provide user-tailored product information based on said user profile, and

interactively rendering said user-tailored product information in said web-based portal in said web browser at said remote site within said computer network, in response to automatically analyzing said user profile using said product configurator (see at least Figs. 20-22 and associated text; cols. 38-40; cols. 43-48).

As to claims 6, 16, 26 (dependent on claims 5, 15, 25 respectively), GERSHMAN discloses

analyzing said user-provided information to determine if said user-provided information contains lead information, generating a database of lead information, in response to identifying lead information from said user-provided information.

(see at least the following excerpt:

Re Lead generation see Detailed Description Text - DETX (403):

Customer Lead Transaction Execution

Detailed Description Text - DETX (404):

The customer lead transaction execution application facilitates the Interface Support Framework and enables the services of the Reporting Subsystem of the Technical Architecture to support the gathering and storing of information about the end-user.)

As to claims 9, 19, 29 (dependent on claims 1, 11, 21 respectively) GERSHMAN discloses assessing an business user (an individual who has a work persona is considered a business enterprise of one) based on a user response to a predetermined query; generating a list of particular user business needs (e.g. travel) based on said assessment comparing said list of particular user needs to a database of products; and matching particular business products maintained in said database with particular items in said list of particular user business needs, thereby identifying particular business products that may be beneficial to said user see at least Figs.12 and associated text; col. 41 lines 39-45). (

As to claims 10 and 20 (dependent on claims 9 and 19) GERSHMAN discloses all the below-listed steps as to an individual user who may also have a business persona.

rendering product-oriented data having particular relevance to said user enterprise in a user interactive field within said web-based portal, in response to matching particular business products (e.g. insurance) maintained in said database of business products with particular items contained in said List of particular user business

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needs (see at least Figs.12 and associated text; col. 41 lines 39-45).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2-3, 8, 12-13, 18, 22-23, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman in view of admitted art.**

As to claims 2, 12, 22 and 3, 13, 23 (dependent on claims 1,11, and 21 respectively) GERSHMAN discloses the methods of claims 1, 11, 21, especially the steps of compiling user-provided information, and automatically analyzing based thereon, as discussed above

However GERSHMAN does not specifically disclose a business to business portal incorporating the steps of the above independent claims.

However it is admitted web-based portals for entrepreneurs and small business are known (Specifications at p. 6 last paragraph).

It would have been obvious to one skilled in the art at the time the invention was made to add to the admittedly known business portals to the portal teachings of GERSHMAN as discussed above to extend GERSHMAN 's advantages to business users.

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Thus it would have been obvious to add to GERSHMAN's steps as discussed above, user-provided business information, to obtain user-tailored business information to effect GERSHMAN's teachings in business to business portal situations.

As to claims 8, 18, 28 . (dependent on claims 1, 11, 21 respectively) GERSHMAN discloses requests by the user of specific business product information and rendering of such to the user (see at least Fig. 22, 23 and associated text: life insurance is business product information) except GERSHMAN does not specifically disclose user made the request via an online application form. Official Notice is taken that requests for any information via filling out request forms, and the processing of such in response thereto to provide the information is well-known. Thus it would have been obvious to one skilled in the art at the time the invention was made to use such well-known requesting method with GERSHMAN's customized portal methods to accommodate users who might like such common method of requesting information.

8. Claims 7, 17, 27 , 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman.

As to claims 7, 17, 27 (dependent on claims 6, 16, 26 respectively) GERSHMAN discloses use of catalogs (see at least the following excerpt :

Detailed Description Text - DETX (431):

A preferred embodiment of a system utilizes a Windows CE PDA equipped with a GPS receiver. The embodiment is configured for a mall containing a plurality of stores. The system utilizes a GPS receiver to determine the user's location. Well structured online catalogs are used. Other embodiments utilize agents that "learn to shop" at a given store using a relatively small amount of knowledge. Moreover, as retailers begin to use standard packages to create online

catalogs, we can expect the number of differing formats to decrease, resulting in a tractable number of competing formats. ...”

Further, GERSHMAN discloses graphical display of requested information via buttons (see at least Figs. 1, 2, 22 and associated text),

GERSHMAN does not specifically disclose displaying brochures information, via clicking on graphical buttons associated with that information but it would have been obvious to one skilled in the art at the time the invention was made to use that technique to display such requested information in GERSHMAN’ web portal.

As to claims 31-33 (dependent on claims 21), Official Notice is taken that it is well-known that software comprises signal-bearing media, including transmission media and recordable media. Thus it would have been obvious to one skilled in the art at the time the invention was made to have each GERSHMAN’s software instructions module on signal-bearing media, transmission media or recordable media because those are the usual software media to use.

Supplemental grounds of rejection

9. First Supplemental grounds of rejection for Claims 9-10, 19-20, 29-30:

Claims 9, 19, 29, 10, 20, 30 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman in view of the admitted art of business portals.

In addition to all of GERSHMAN’s disclosures pertaining to these claims, as to an individual user, as discussed above in the 35 USC § 102 section, it would have been obvious to one skilled in the art at the time the invention was made to add to the portal features and teachings of GERSHMAN as discussed above, as pertaining to these claims, the admittedly

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known business portals, to extend the advantages taught by GERSHMAN such as customized portals to business portals and business users.

10. Second Supplemental grounds of rejection for Claims 9-10:

Method claims 9, and 10 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman.

In addition to all of GERSHMAN's disclosures pertaining to these claims, as discussed above in the 35 USC § 102 section, patentability shouldn't be hinged on who the entity is that is doing the transaction.

Initially, note Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961): *"As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. To be entitled to such weight #7 method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here."*

In this case, there does not seem to be any impact on the manipulative steps of the method of these claims because of the "type" of company doing the actions. Thus, the name, legal status or ownership of the entity performing the action does not seem to functionally change the action required by the step. In other words, a here, a business user is doing nothing more than the GERSHMAN user, and the information, business information, is non-functional data that does not affect the steps.

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10. Supplemental grounds of rejection for system and program product claims 12-13, 22-23, 19, and 29.

Claims 12-13, 22-23, 19, 29 are rejected under 35 U.S.C. 103 as being unpatentable over GERSHMAN.

GERSHMAN teaches an interactive Internet portal system and program product, with modules to support all claimed functions as discussed above. However, GERSHMAN does not teach the specific business data recited in the claimed invention.

However, the specific meaning/interpretation of the queries (user enterprise data) loaded onto the server, or program product does not patentably distinguish the claimed system or program product. Further, the recited statement of intended use, to assess a user enterprise to provide specific business products information does not patentably distinguish the claimed system or program product. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of queries or data in response thereto, in the system taught by GERSHMAN, because the subjective interpretation of the queries/data in response thereto, does not patentably distinguish the claimed inventions: a network system or a program product. Further all the business data are non-functional data on which patentability cannot be hinged.

Conclusion

11. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

“i2 Brings viaLink Item Catalog(TM) Services to TradeMatrix, the Only Intelligent eBusiness Portal.”, PR Newswire, p5348, Oct 13, 1999, Dialog File 16, Record # 06720108, discloses
customized business portals with joint sales and marketing programs.

USADATA.com Teams with ROI Research to Collect and Deliver Research Online, Business Wire, p0219, Sept 27, 1999 , Dialog File 16, Record # 06662292 discloses customized business-to-business e-commerce portals for corporate customers tailored to their specific sales and marketing process and information needs, on-line data collection to gauge immediate consumer reactions, on-line access to marketing research such as polls, evaluation of corporate marketing programs.

“CitX and PRSI Announce Strategic Marketing Alliance”, PR NEWSWIRE, September 09, 1999, Dialog File 20 , Record # 07125565 discloses a unique personalized business member Web site portal, with built-in Web-based lead generation management tools, order fulfillment and customer management tools, interactive product catalogs, Marketing Alliance Referral Programs and more (see at least 2nd to 5th full paragraphs). This reference could be combined with Gershman to reject all claims.

Guheen et al. , US 6721713 B1, discloses business to business portals w/ targeted catalogs.

Gervais et al., US 6381579 B1 discloses an electronic-business-to-electronic-business portal that organizes the access to extended business applications.

Bowman-Amuah, US 6345239 B1, discloses extension from BTC to business to business.

Admitted art: web-based portals for entrepreneurs and small business implemented in the form of a series of on-line brochures or catalogues . Specifications at p. 6 last paragraph.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00.

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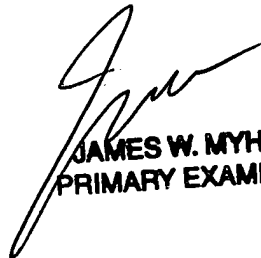
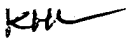
The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov. (However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

September 20, 2004

KHL



JAMES W. MYHRE
PRIMARY EXAMINER